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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Thomas G. Lapcevic

Title: SYSTEM AND METHOD FOR BRANDING A FACILITY

Appl. No.: 09/598,506

Filing Date: June 21, 2000

Examiner: Daniel Lastra

Art Unit: 3622

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June 7, 2007
(Date of Deposit)

Terence P. O'Brien
(Printed Name)

(Signature)

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

In response to the Notification of Non-Compliant Appeal Brief mailed June 1, 2007, Appellants are submitting herewith an amended Appeal Brief in which Section III has been amended to refer to correct a typographical error. The present Appeal is directed to claims 1-19, and not limited to claims 10-19.

Appellants believe that no fee is due at this time. However, if Appellants are mistaken and a fee is due, please charge any fees related to the Response to Notification of Non-Compliant Appeal Brief to Deposit Account 501959.

Respectfully submitted,

Date 7 June 2007

By _____

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APPEAL BRIEF UNDER 37 CFR 41.37

Mail Stop Appeal Brief - Patents
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Dear Sir:

I. Real party in interest.

The real party in interest is ClubCom Inc., the assignee of the present Application (as recorded at reel 013707, frame 0953).

II. Related appeals and interferences.

There are no applications, patents, appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of claims.

Claims 1-19 are pending in the Application. Claims 1, 8 and 14 have been amended. The present Appeal is directed to claims 1-19, which were finally rejected in an Office Action mailed on July 24, 2006.

IV. Status of amendments.

An Amendment filed on October 19, 2006, subsequent to final rejection, is reflected in the Appendix.

V. Summary of claimed subject matter.

The present application describes a computer-assisted method of establishing a brand presence in a facility such as a health club. The present invention provides a system and method of delivering entertainment and advertising content to facilities that use relatively inexpensive playback systems. Audio and video content are stored in a content database housed in a central facility. The audio and video content contain both advertising content and entertainment content. The advertising content contains both advertisements related to the facility and local advertisements. The local advertisements can be created consisting of standard and customized content. Personnel from a remote facility access via a medium such as for example the Internet a central network computer at a central office. The central network computer includes a playlist that controls the playback of audio and video broadcasting within the remote facility. The facility personnel enter on the playlist identifiers of advertisements. The playlist is transferred, or pushed, to the remote facility, which playlist includes advertisements related to the remote facility.

Independent claim 1 recites a computer assisted method of establishing a brand presence in a remote facility 12 and 14 (pages 9-25). The method includes accessing, by remote facility personnel, a central network computer 18 housed in a central facility 16 (page 8) having a playlist that controls the playback of audio and video broadcasting within the remote facility 12 and 14 (page 9), wherein the playlist comprises free entertainment and advertisement content (page 9, lines 10-17 and page 10, lines 16-21). The method also includes entering on the playlist, by remote facility personnel, identifiers of advertisement

content related to the remote facility (page 12, lines 10-24, and page 13, lines 1-4), and the central computer network accesses the playlist entered by the remote facility personnel and pushes to the remote facility the playlist (page 13 and page 15).

Independent claim 8 recites a computer assisted method of establishing a brand presence in a remote facility 12 and 14 (pages 9-25). The method includes accessing, by facility personnel and via the Internet 32 (page 11, lines 5-13), a computer 18 housed in a central facility 16 (page 8) having a playlist that controls the playback of audio and video broadcasting within the remote facility (page 9), wherein the playlist comprising free entertainment and advertisement content (page 9, lines 10-17 and page 10, lines 16-21). The method also includes entering on the playlist, by remote facility personnel, identifiers of advertisement content related to the facility (page 12, lines 10-24, and page 13, lines 1-4). The central computer network accesses the playlist entered by the remote facility personnel and pushes via the Internet to the remote facility the playlist (page 13 and page 15).

VI. Grounds of rejection to be reviewed on appeal.

1) Claims 1, 8 and 14 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. However, the Amendment filed on October 16, 2006 deletes the language from claims 1, 8 and 14 that prompted the rejection.

2) Claims 1-19 have been rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,456,981 to *Dejaeger et al.* in view of U.S. Patent No. 6,553,404 to *Stern*.

Specific arguments related to the patentability of different language in claims 1-7, claims 8-13, and claims 14-19 are presented.

V. Argument.

I. CLAIMS 1, 8 AND 14 ARE IN COMPLIANCE WITH THE WRITTEN DESCRIPTION REQUIREMENT OF 35 U.S.C. 112, FIRST PARAGRAPH.

In the final Office Action, mailed July 24, 2006, claims 1, 8 and 14 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In the Amendment filed on October 19, 2006, claims 1, 8 and 14 were amended to remove the language that was the subject of the rejection. Appellants respectfully request the Board to vacate this rejection.

II. CLAIMS 1-19 ARE PATENTABLE OVER *DEJAEGER ET AL.* IN VIEW OF *STERN* UNDER 35 U.S.C. 103(a).

In the final Office Action, mailed July 24, 2006, claims 1-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Dejaeger et al.* (U.S. Patent No. 6,456,981) in view of *Stern* (U.S. Patent No. 6,553,404).

U.S. Patent No. 6,456,981 to *Dejaeger et al.* ("*Dejaeger*") describes a method for displaying a customized advertising message on a display monitor in a check-out terminal such as a grocery or department store. By customized, *Dejaeger* specifically targets advertising to individual shoppers. Advertising messages are displayed on the display monitor based on the retail information of the shopper. Retail information is included in a user profile associated with a user's previous activity at the grocery or department store. The check-out terminal is operated so as to allow the user to enter items for purchase into the retail checkout terminal – self service checkout. The retail information included in the user profile is retrieved. An advertising message is generated based on the retail information of the user profile. The advertising message is communicated to the user on the display monitor associated with the retail checkout terminal. An individual customized customer survey and coupons can also be provided to the shopper. Thus, *Dejaeger* does not disclose, teach or suggest the combination of advertising content with entertainment content.

The Examiner argues that *Dejaeger* discloses entertainment content. In fact, even while admitting "that *Dejaeger* teaches a playlist which consists of advertisements and online surveys" (Office Action of 6 February 2006), the Examiner argues that "said online survey would be classified as entertainment, as customers are remunerated for giving their opinions about different subjects". *Id.* The Examiner also stated, "[t]he Examiner wants to mention that he is a member of different Internet online survey systems and the Examiner has a lot of fun filling said surveys as he is remunerated for filling said surveys." *Id.* In spite of Applicant's traversal of the rejection based on the classification of a "survey" as "entertainment", in the Final Office Action the rejection was maintained.

Merriam-Webster defines "entertainment" as "something diverting or engaging: as **a:** a public performance **b:** a usually light comic or adventure novel." http://www.m-w.com. "Survey" is defined as "**1 a:** to examine as to condition, situation, or value: appraise **b:** to query (someone) in order to collect data for the analysis of some aspect of a group or area." *Id.* A reasonable person, including a person of ordinary skill in the art, would not consider a survey to be entertainment.

In fact, Merriam-Webster notes that an ***obsolete*** meaning of entertainment is "employment." *Id.* This flies in the face of the argument that receiving remuneration is entertainment.

In addition, the Examiner cites to column 15, lines 5-16 in arguing that *Dejaeger* discloses "entering on the playlist, by facility personnel, identifiers of advertisements related to the facility." In fact, this paragraph does not disclose, describe or teach this step of establishing a brand presence in a facility. Rather, this paragraph describes the unremarkable proposition that the server determines if another advertising message is to be displayed on the self-service checkout terminal:

> "In step 122, the central server 42 determines if an additional advertising message is to be displayed on the self-service checkout terminal 18. In particular, the retailer may configure the retail system 10 such that advertising messages are displayed during the entire checkout operation, or alternatively,

> the retailer may elect to only display a predetermined number of messages during a given transaction. Hence, in step 122, if an additional advertising message is to displayed on the self-service checkout terminal 18, the subroutine 116 advances to step 124. If no additional advertising messages are to be displayed on the self-service checkout terminal 18, the subroutine 116 then ends thereby advancing the routine 100 (see FIG. 5) to a survey subroutine 126."

Thus, this fails to disclose, describe or teach "identifiers of advertisements related to the facility." For this additional reason, the rejection of claims 1-19 should be reversed.

In addition, the only thing this paragraph identifies that the retailer can configure is whether a predetermined number of advertisements are played or whether advertisements are played during the entire checkout operation. Thus, this fails to disclose, describe or teach "entering on the playlist, by facility personnel, identifiers of advertisements related to the facility." For this additional reason, the rejection of the claims should be withdrawn.

Still further, the claims alternatively specify that it is a "central network computer" and a "remote facility" (claims 1-7); that the facility personnel access the computer having a playlist that controls the playback of audio and video broadcasting within the facility via the Internet (claims 8-13); and that the playlist which includes advertisements related to the facility is pushed to the facility (claims 14-19). None of these requirements are disclosed, described or taught by *Dejaeger*.

The Examiner attempts to buttress the teachings of *Dejaeger* by applying U.S. Patent No. 6,553,404 to *Stern*, arguing that *Stern* "teaches a system that delivers entertainment (i.e. music) and advertising content to commercial outlets from a central system." However, nowhere does the Examiner attempt to justify this combination. In fact, the combination of *Dejaeger* and *Stern* would necessarily result in providing entertainment content to shoppers at a check-out terminal in a grocery or department store. *Dejaeger* specifically teaches the undesirability of this:

> "It should be appreciated that the number of questions included in a given retail survey displayed on the marketing portion 22a of the display monitor 22 may be altered based on usage of the self-service checkout terminal 18. For example, during periods of relatively high usage of the self-service checkout terminal 18, the

> number of questions in a given retail survey may be reduced in order to enhance throughput through the terminal 18."

(*Dejaeger* Column 11, lines 40-47). If the number of survey questions could damage throughput through the checkout terminal it is not difficult to imagine the damage entertainment content could do.

In addition, the Examiner recognizes that *Dejaeger* does not teach an Internet connection to a central network computer from a remote facility. Thus, the Examiner further relies on *Stern*, citing column 10, lines 45-56. Column 10, lines 45-56 of *Stern* describes the "Communication Network" thusly:

> "NCO 120 [sic, NOC (Network Operations Center)] communicates digitized data files 122 to a commercial sales outlet 130 via a communications network 125. Communications network 125 can be implemented in any one of several technologies. For example, a satellite link can be used to distribute digitized data files 122 to commercial sales outlet 130, as described below. This allows content to easily be distributed by broadcasting (or multicasting) the content to various locations. However, any response by the systems are those locations must be accomplished in some other manner, such as by leased line, public telephone line, the Internet, or some other comparable mechanism."

Thus, *Stern* does not disclose, teach or suggest the combination of advertising content with entertainment content.

III. CONCLUSION

For the reasons stated above, it is respectfully submitted that all of the claims recite patentable subject matter and are in condition for allowance. Accordingly, Appellants respectfully request the Board reverse the rejection of claims 1-19.

Respectfully submitted,

Date 7 June 2007

By _____

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APPENDIX

1. A computer assisted method of establishing a brand presence in a remote facility, comprising:

accessing, by remote facility personnel, a central network computer housed in a central facility having a playlist that controls the playback of audio and video broadcasting within the remote facility, the playlist comprising free entertainment and advertisement content;

entering on the playlist, by remote facility personnel, identifiers of advertisement content related to the remote facility; and

the central computer network accessing the playlist entered by the remote facility personnel and pushing to the remote facility the playlist .

2. The method of claim 1, further comprising selecting, by remote facility personnel, a supplemental advertisement campaign.

3. The method of claim 2, wherein the supplemental advertisement campaign is selected from the group consisting of a print campaign, an email campaign, and combinations thereof.

4. The method of claim 1, further comprising reserving, by an organization affiliated with the remote facility, certain time slots for advertisements relating to the organization.

5. The method of claim 1, wherein entering the playlist includes entering on the playlist, by remote facility personnel, identifiers of advertisements to be played in a portion of the remote facility.

6. The method of claim 1, further comprising pushing to the remote facility, via a medium selected from the group consisting of the Internet, satellite links, and combinations thereof, the playlist.

7. The method of claim 1, further wherein the step of accessing, by remote facility personnel, the central network computer further comprises accessing, via the Internet, the central network computer.

8. A computer assisted method of establishing a brand presence in a remote facility, comprising:

accessing, by facility personnel and via the Internet, a computer housed in a central facility having a playlist that controls the playback of audio and video broadcasting within the remote facility, the playlist comprising free entertainment and advertisement content;

entering on the playlist, by remote facility personnel, identifiers of advertisement content related to the facility; and

the central computer network accessing the playlist entered by the remote facility personnel and pushing via the Internet to the remote facility the playlist .

9. The method of claim 8, further comprising selecting, by remote facility personnel, a supplemental advertisement campaign.

10. The method of claim 8, further comprising reserving, by an organization affiliated with the remote facility, certain time slots for advertisements relating to the organization.

11. The method of claim 8, wherein entering the playlist includes entering on the playlist, by remote facility personnel, identifiers of advertisements to be played in a portion of the remote facility.

12. The method of claim 8, further comprising pushing to the remote facility, via a medium selected from the group consisting of the Internet, satellite links, and combinations thereof, the playlist, which playlist includes advertisements related to the remote facility.

13. The method of claim 8, further wherein accessing, by remote facility personnel via the Internet, the computer further comprises accessing, by remote facility personnel via the Internet, a central network computer.

14. A computer assisted method of establishing a brand presence in a remote facility, comprising:

accessing, by remote facility personnel, a computer housed in the central facility having a playlist that controls the playback of audio and video broadcasting within the remote facility, the playlist comprising free entertainment and advertisements;

creating at least one advertisement containing standard and customized content;

entering on the playlist, by facility personnel, identifiers of at least one advertisement, the advertisements containing standard and customized content; and

pushing to the remote facility the playlist, which playlist includes at least one advertisement related to the remote facility.

15. The method of claim 14, further comprising selecting, by remote facility personnel, a supplemental advertisement campaign.

16. The method of claim 14, further comprising reserving, by an organization affiliated with the remote facility, certain time slots for advertisements relating to the organization.

17. The method of claim 14, wherein entering the playlist includes entering on the playlist, by remote facility personnel, identifiers of advertisements to be played in a portion of the remote facility.

18. The method of claim 14, further wherein pushing to the remote facility comprises pushing to the remote facility via a medium selected from the group consisting of the Internet, satellite links, and combinations thereof.

19. The method of claim 14, further wherein accessing, by remote facility personnel via the Internet, the computer further comprises accessing, by remote Facility personnel via the Internet, a central network computer.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None